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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TORU OZAKI, MAKOTO YOSHIOKA,
and HIDEFUMI AOE

Appeal 2009-000700
Application 09/933,766
Technology Center 3600

Decided: October 22, 2009

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the rejection of claims 1-9 and 28-29 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed a commerce information distribution system having a station broadcasting a commercial message broadcast and information relating to the broadcast. A terminal transmits commercial message broadcast designation information to a commerce outsourcing center. (Spec. 7:9-25). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A commerce information managing method for managing commerce information, comprising:

receiving a request to generate a commercial message broadcast and commercial message information relating to the commercial message broadcast from at least one of a merchandise producer and a service provider;

requesting a concurrent broadcast of the commercial message broadcast and the commercial message information relating to the commercial message broadcast generated according to commerce information, during broadcast of a main program;
and

receiving at a broadcast reception terminal device of a client, as part of the commerce information, commercial message

broadcast designation information contained in the commercial message information and designating at least the commercial message broadcast when the client sees the commercial message broadcast, performs an instruction for displaying the commercial message information relating to the commercial message broadcast and purchases merchandise or a service in the commercial message information relating to the commercial message broadcast.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Mayer	US 5,774,534	Jun. 30, 1998
Sahota	US 2002/0010928A1	Jan. 24, 2002

The following rejections are before us for review:

1. Claims 1-3, 6-9, and 28-29 are rejected under 35 U.S.C. § 102(e) as anticipated by Sahota.
2. Claims 4-5 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sahota and Mayer

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 1-7, 9, and 28-29, this issue turns on whether the term “commercial message broadcast designation information ...designating at least the commercial message broadcast” as recited in claim 1 for example is non-functional descriptive material and disclosed by the Sahota reference.

With regards to claim 8, this issue turns on whether the term “shop” is broad enough to encompass an Internet retailer.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:¹

FF1. Sahota discloses a method and system for integrating Internet advertising with television commercials (Title and Abstract).

FF2. Sahota discloses that Internet advertising content may be integrated with TV commercial content for display (Abstract).

FF3. Sahota discloses the display of both a commercial 520 and an Internet address 510 on a TV 104 (Fig. 5A).

FF4. Sahota discloses that a user of a TV can launch interactive services by accessing content 510. For example, a user accessing interactive content 510 will begin interacting with a website as shown in Fig. 5B [0061].

FF5. Sahota discloses the use of Internet 10 systems in the method (Fig. 1).

PRINCIPLES OF LAW

Principles of Law Relating Claim Construction

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech.*

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need

for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16.

ANALYSIS

1-7, 9 and 28-29

The Appellants argue that the rejection of claim 1 is improper because Sahota fails to disclose “commercial message broadcast designation information...designating at least the commercial message broadcast” as recited in claim 1 at lines 10-11 (Br. 5, Reply Br. 2-4). The Appellants argue that Sahota only discloses the website address of a retailer and that this does not designate the commercial message in anyway (Br. 5). The Appellants argue that nothing in Sahota suggests the content of the TV and data broadcast might provide the capability to designate what commercial was viewed by a client (Br. 5). The Appellants have also argued the cited above limitation in claim 1 is not non-functional descriptive material but required for the operations of the method and functionally related to the recited method (Br.8-9, Reply Br. 5-7).

In contrast, the Examiner has determined that the cited limitation for “commercial message broadcast designation information...designating at least the commercial message broadcast” as recited in claim 1 is non-functional descriptive material (Ans. 10-11). The Examiner has further determined that Sahota anticipates claim 1 regardless of the limitation being non-functional descriptive material (Ans. 8-10).

We agree with the Examiner. We begin first by determining whether the cited limitation in claim 1 for “commercial message broadcast

designation information...designating at least the commercial message broadcast” is non-functional descriptive material.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Exemplary “functional descriptive material” consists of data structures and computer programs, which impart functionality when employed as a computer component. “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. When functional descriptive material is recorded on some computer readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. *Compare In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) with *In re Warmerdam*, 33 F.3d 1354, 1361-62 (Fed. Cir. 1994) (claim to computer having a specific data structure stored in memory held statutory product-by-process claim but claim to a data structure that referred to ideas reflected in nonstatutory process rather than referring to a physical arrangement of the contents of a memory held nonstatutory).

When presented with a claim including nonfunctional descriptive material, an Examiner must determine whether such material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See*

Gulack, 703 F.2d at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981).

However, the PTO need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See Gulack*, 703 F.2d at 1386. *See also In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004); *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). The burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO. *In re Lowry*, 32 F.3d at 1584. We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability. That is, we conclude that such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

Here with regards to claim 1 the Appellants argue that the last four lines of claim 1 describe what happens after the information recited on lines 9-11 of claim 1 is received “at a broadcast reception terminal device of a client” i.e., “the client...performs an instruction for displaying the commercial message information relating to the commercial message broadcast and purchase merchandise or a service in the commercial message information relating to the commercial message broadcast” (Reply Br. 5-6).

We disagree. We find in claim 1 there is not a functional relationship between the operation of the method steps and the “commercial broadcast message designation information contained in the commercial message

information” recited in the claim. Claim 1 requires receiving at a broadcast reception device of a client “commerce information” which includes in part data that is “commercial message broadcast designation information” which as recited in the claim is merely provided data and which imparts no functional relationship to the operation of the method step of receiving the commerce information and is only data. Note that the term “commercial message broadcast designation information” is not even referenced anywhere else in the claim where a functional relationship could be shown to occur. Thus, the claim limitations cited by the Appellants are considered non-functional descriptive matter.

Here, Sahota discloses that the TV receives and displays both a commercial 520 and an Internet address 510 (FF3) which serves as “commercial message information” meeting the cited and argued claim requirements in claim 1. We do not find the subject matter of the operational data “designation information” to be a patentable distinction since Sahota discloses the method steps and the “designation information” in the claimed method does not functionally change the implemented method in that it does not alter how the process steps are to be performed to achieve the utility of the invention. Rather, these data elements are analogous to printed matter in that they represent merely underlying data in a database. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994). As such, the Appellants have failed to demonstrate error in the Examiner’s determination of anticipation of claim 1 under 35 U.S.C. § 102(e) as unpatentable over Sahota.

This case is distinguished from *Lowry*, because in *Lowry* the claims were directed to data structures stored in memory that contained both

information used by application programs and information regarding their physical interrelationships within a memory. *Id.* As such, the court found that the claimed data structures of Lowry's invention were not analogous to printed matter because they managed information by imposing a physical organization on the data and provided increased computing efficiency. *Id.* By contrast, the present invention is directed to a method where the only distinction to the prior art is the content of the data elements. Unlike in *Lowry*, the data in the present case does not impose any functional requirements on the claimed method or otherwise depend functionally on the information content of the data elements which relate to commercial message information. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). *See also Ex parte Mathias*, No. 2005-1851 (BPAI Aug. 19, 2005), *aff'd. In re Mathias*, No. 2006-1103, 2006 WL 2433879 (Fed. Cir. Aug. 17, 2006) (Rule 36, unpublished) and *Ex parte Curry*, No. 2005-0509 (BPAI Jun. 30, 2005), *aff'd. In re Curry*, No. 2006-1003 (Fed. Cir. Jun. 12, 2006) (Rule 36, unpublished) (both cases treating data as nonfunctional descriptive material).

Regardless, even if the limitation in claim 1 for “commercial message broadcast designation information...designating at least the commercial message broadcast” was not considered to be non-functional descriptive material, we still find Sahota to disclose the cited limitation. Sahota discloses that an Internet website 510 may be displayed as advertisement in

Fig. 5A (FF3). Given the broadest reasonable interpretation, the Internet address alone serves as a “commercial message information” and the website address displayed serves as “commercial message broadcast designation information.” There is no requirement in claim 1 that the commercial message broadcast must consist of two components including both the TV commercial and the Internet address. Sahota’s Internet address alone may serve as “commercial message information” and “commercial message broadcast designation information.” For these reasons, the rejection of claim 1 is sustained. The Appellants have provided the same or similar arguments for claims 4-5 and 28-29 and the rejection of these claims are sustained as well.

Claim 8

The Appellants separately argue that the rejection of claim 8 is improper because the word “shop” refers to a physical location and not an Internet website.

We disagree. Turning to the Appellants’ Specification we note that it refers to the use of Internet 7 systems (FF5). Giving the term “shop” its broadest reasonable interpretation in light of the Specification we take this to include Internet “shops.” For these reasons the rejection of claim is sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 6-9, and 28-29 under 35 U.S.C. § 102(e) as anticipated by Sahota.

Appeal 2009-000700
Application 09/933,766

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 4-5 under 35 U.S.C. § 103(a) as unpatentable over Sahota and Mayer.

DECISION

The Examiner's rejection of claims 1-9 and 28-29 is sustained.

AFFIRMED

JRG

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